

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Anton F. Wilson Art Unit : 3618
Serial No. : 10/603,248 Examiner : Kelly E. Campbell
Filed : June 25, 2003
Title : SKI WITH TUNNEL AND ENHANCED EDGES

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ACTION OF NOVEMBER 3, 2005

Please respectfully request reconsideration in view of the following remarks.

REMARKS

The Claimed Invention

Applicant's claims feature skis including a ski body having a tip, a tail, ski sides, and a boot binding region, a lower surface of the ski body forming a planar running surface for contacting a skiing surface, and ski edges extending along each ski side of the ski body adjacent the running surface between the tip and tail, one surface of each ski edge being an outer side.

In one aspect, recited in claim 1, the outer side is exposed along the ski side, and a second surface lies substantially in the plane defined by the planar running surface, for contact with the skiing surface when the running surface is flat on the skiing surface. At least one recessed area forms at least one channel in the running surface, the channel extending alongside and parallel to at least one of the ski edges of the ski for at least part of the length of the ski body to expose an inner side surface of the ski edge.

In another aspect, recited in claim 10, at least a portion of an inner side of one of the ski edges is exposed to the skiing surface, the exposed inner side and corresponding outer side forming an edge tip that lies substantially in the plane defined by the planar running surface, for contact with the skiing surface when the running surface is flat on the skiing surface.

Rejection under 35 U.S.C. §103(a)

All of the claims under consideration have been rejected under 35 U.S.C. 103(a) as unpatentable over Diard in view of Hess. This rejection is respectfully traversed.

The Examiner acknowledges that Diard does not teach or suggest a recessed area exposing part of the ski edge. The Hess reference, which was relied upon as the primary reference in the previous rejection, is cited to supply a teaching of a recess. The Examiner contends that "it would have been obvious ... to modify the ski having edges with a bottom surface in the plane defined by the running surface, as taught by Diard et al., to include recesses as taught by Hess, to facilitate rapid turns of the ski as the snow can escape through the recesses." Applicant respectfully disagrees.

Assuming for the sake of argument that the references could be properly combined, which Applicant does not concede, Applicant respectfully submits that the Examiner has not established *prima facie* obviousness. Neither reference teaches or suggests an edge having a surface in the plane of the running surface and an exposed inner surface, a feature which is present in both of Applicant's independent claims. This feature cannot simply be pulled out of thin air by combining the two references.

Combining these two references would not have yielded the claimed invention because the artisan would have been motivated (if motivated at all) to replace the conventional edges of Diard, which lie in the plane of the running surface, with Hess's elevated and/or angled edges. The edges disclosed in Hess lie in a different plane. As noted in Applicant's previous response, Hess teaches explicitly away from Applicant's claimed geometry, stating that it is undesirable to have the ski edges "located at the level of contact or running surface of the ski with a consequence that the edges are permanently in action and the ski will be difficult to maneuver because the edges will continuously cut into the snow" (col. 1, lines 38-42). Hess repeatedly emphasizes that, in order to obtain the benefits he is seeking, the edges should not contact the snow when the running surface of the ski is flat on the snow, but instead only when the ski is tilted to initiate a turn. (See, e.g., col. 4, lines 55-61). There is no teaching or suggestion whatsoever in either reference that would have suggested to the artisan that *any advantage* would be obtained by forming a recess between an edge having a surface in the plane of the running surface and the running surface.

Teaching away is the opposite of the art's suggesting that the person of ordinary skill experiment in the claimed direction. A reference must be considered as a whole and the portions arguing against a teaching away from the claimed invention must be considered. Thus, teaching away from the art is a per se demonstration of lack of *prima facie* obviousness. In re Dow Chemical Co., 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); and In re Nielson, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987).

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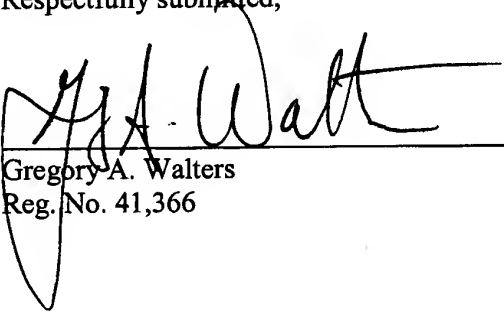
Conclusion

In view of the above remarks, Applicant respectfully requests that all claims be allowed.

It is believed that no fees are due with this response. Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 17984-003001.

Respectfully submitted,

Date: February 3, 2006



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